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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHELL S. SIMPSON, WARD S. FOSTER, and
KRIS R. LIVINGSTON

Appeal 2007-003926
Application 09/993,116
Technology Center 2100

Decided:¹ July 24, 2009

Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*,
JAMES D. THOMAS and ST. JOHN COURTENAY III,
Administrative Patent Judges.

COURTENAY, Administrative Patent Judge.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Data (electronic delivery).

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 37-42, 44, 46-54, 56, 57, and 59-66. Claims 1-36, 43, 45, 55, and 58 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

THE INVENTION

Appellants' invention relates generally to processing data in a distributed environment. More particularly, Appellants' invention relates to a system for automatically identifying and extracting text information in a web based imaging computing environment. (Spec. 1).

Claim 37 is illustrative:

37. A system comprising:

a browser having an applications program interface (API) and a user identification (ID) coupled to the API, the user ID comprising a reference to a user profile associated with a profile store, the user profile comprising a reference to a graphics store and a composition store associated with a user, the API exposed to web content downloaded to the web browser over a network, the web content comprising one or more graphics;

a user profile server comprising the profile store, wherein the profile store comprises user specific data;

a graphics server comprising the graphics store, wherein the graphics store is configured to enable network access by the browser of the one or more graphics; and

a composition server comprising the composition store, wherein the composition store comprises one or more compositions that determine the manner in which the one or more graphics are mapped into a series of web pages,

wherein the browser is coupled over a network to the user profile server, the graphics server, and the composition server, and wherein the API is configured to make the user specific data and the one or more graphics formatted according to the one or more compositions available to a first web service, wherein the API is configured to enable the first web service to perform optical character recognition on the one or more graphics in response to a request by the first web service for information pertaining to the user profile.

PRIOR ART

The Examiner relies upon the following references as evidence in support of the obviousness rejections:

Bradford	US 5,805,747	Sep. 8, 1998
Gillespie	US 2002/0059243 A1	May 16, 2002
Gudorf	US 2002/0174230 A1	Nov. 21, 2002

THE REJECTIONS

1. The Examiner rejected claims 37-42, 47-54, 56, 57, and 59-66 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Gudorf and Bradford.
2. The Examiner rejected claims 44 and 46 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Gudorf, Bradford, and Gillespie.

GROUPING OF CLAIMS

Based upon Appellants' arguments in the Briefs, we will decide this appeal based upon representative independent claims 37, 56, and 66. *See* 37 C.F.R. § 41.37(c)(1)(vii).

APPELLANTS' CONTENTIONS

Appellants contend that neither Gudorf nor Bradford teaches a user profile that comprises a reference to a composition store associated with a user (App. Br. 13). Appellants further contend that neither Gudorf nor Bradford teaches a browser having an applications program interface (API) and a user identification (ID) coupled to the API (App. Br. 14). Appellants also contend there is no teaching or suggestion in the references to use separate servers for the graphics store and composition store (App. Br. 15). Appellants further contend that the Examiner has relied upon hindsight in combining the cited references. (App. Br. 16).

EXAMINER'S FINDINGS

The Examiner maintains that each of the aforementioned limitations argued by Appellants is taught or suggested by the cited combination of references. The Examiner further maintains that the references have been properly combined (Ans. 11-14).

ISSUES

Based upon our review of the administrative record, we have determined that the following issues are dispositive in this appeal:

1. Have Appellants shown that the Examiner erred in finding the combination of Gudorf and Bradford teaches or suggests a user profile that comprises a reference to a composition store associated with a user? (See representative claims 37, 56, and 66).
2. Have Appellants shown that the Examiner erred in finding that the combination of Gudorf and Bradford teaches or suggests a browser having an applications program interface (API) and a user identification (ID) coupled to the API? (See representative claim 37).
3. Have Appellants shown that the Examiner erred in finding that the combination of Gudorf and Bradford teaches or suggests using separate servers for the graphics store and composition store? (See representative claim 37).
4. Have Appellants shown the Examiner erred by improperly combining the Gudorf and Bradford references? (See representative claims 37, 56, and 66).

PRINCIPLES OF LAW

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 419 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

Invention or discovery is the requirement which constitutes the foundation of the right to obtain a patent . . . unless more ingenuity and skill were required in making or applying the said improvement than are possessed by an ordinary mechanic acquainted with the business, there is an absence of that degree of skill and ingenuity which constitute the essential elements of every invention.

Dunbar v. Myers, 94 U.S. 187, 197 (1876) (citing *Hotchkiss v. Greenwood*, 52 U.S. 248, 267 (1850)) (*Hotchkiss v. Greenwood* was cited with approval by the Supreme Court in *KSR*, 550 U.S. at 406, 415, 427).

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). Therefore, we look to Appellants' Briefs to show error in the Examiner's proffered prima facie case.

FINDINGS OF FACT

In our analysis *infra*, we rely on the following findings of fact (FF):

THE GUDORF REFERENCE

1. Gudorf teaches the use of an HTML-compatible web browser (para. [0040]).
2. Gudorf teaches "a personalized on-line interface system 80 advantageously assesses the subjective preferences of a user 82 in a local on-line environment 84 who accesses a hypertext document or file 86 from a remote on-line environment 88." (para. [0041]; Fig. 3).

3. Gudorf teaches “[p]erforming a portion of the user characterization remotely advantageously allows the system 80 to conveniently personalize on-line content for the user 82 who uses multiple computer platforms 98 (e.g., home desktop computer, office computer, portable device).” (para. [0043]).
4. Gudorf teaches: “[t]he user characterization database 96 is accessed by a publisher of a web site, depicted as a portal provider 100, to personalize default portal templates 102 with associated content 104. In particular, the portal provider 100 . . . matches associated content 104 with the user characterization database 96 to populate a selected default template 102 with personalized on-line content 106.” (Para. [0045]).
5. Gudorf teaches: “[a] plurality of usage profiles are personalized to reflect the monitored subjective preferences for the user corresponding to each of the computing environments. Then, the personalized on-line content is presented in accordance with the usage profile appropriate for the current computing environment.” (para. [0011]).
6. Gudorf teaches “[t]he usage profile is characterized for this workplace computing environment,” as shown in Figures 6 and 7 (para. [0056]).
7. Gudorf teaches that online content is identified that is related to the user characterization and displayed on the portal web page provided to the user (para. [0055]).

THE BRADFORD REFERENCE

8. Bradford teaches that the OCR system 104 operates as a resource in a network environment (col. 7, ll. 50-51).
9. Bradford teaches that storage unit 103 is connected to the scanning workstation over a network 109 where the OCR system 104 is connected to receive the digital page image from the storage unit 103 (col. 6, l. 61 through col. 7, l. 1).
10. Bradford teaches that the digital page image could be created at some remote location and brought into the system from a device connected to the network (col. 7, ll. 3-7).
11. Bradford teaches that an Application Program Interface (API) must be provided to allow various devices to interact with the OCR system 104, and also that the API communicates with the OCR system 104 using data packets (col. 7, ll. 52-56).

ANALYSIS

At the outset, we consider Appellants' arguments in the Briefs only to the extent that such arguments are directed to claimed subject matter.

ISSUE 1

We decide the question of whether Appellants have shown the Examiner erred in finding that the combination of Gudorf and Bradford teaches and or suggests a user profile that comprises a reference to a composition store associated with a user (See representative claims 37, 56, and 66).

The Examiner notes that Gudorf teaches a login screen that allows a user to identify himself/herself (Ans. 11, referencing Gudorf's paragraph [0004]). The Examiner further points to Gudorf's paragraph [0045] (and Figure 3) as teaching default portal templates 102 that are populated with associated content 104 (Ans. 12; *see also* FF 4). The Examiner clarifies in the Answer that the claimed "composition store" is taught or suggested by Gudorf's associated content 104 element. (Ans. 12). The Examiner also points to Gudorf's personalized user preferences contained in the characterization database (Ans. 12; *see also* FF 4).

In the Reply Brief, Appellants submit that Gudorf's associated content 104 is not the same as or equivalent to the claimed "composition store." Appellants note that the claim requires the composition store to comprise one or more compositions that determine the manner in which the one or more graphics are mapped into a series of web pages (Reply Br. 2).

Based upon our review of the evidence, we find the portions of Gudorf cited by the Examiner are at least suggestive of Appellants' aforementioned argued limitations. Moreover, we find Gudorf teaches a plurality of usage profiles that are personalized (i.e., a usage profile associated with a particular user) so as to suggest the claimed user profile. (FF 5). In addition, Gudorf teaches that "personalized on-line content is presented in accordance with the usage profile appropriate for the current computing environment." (FF 5; *see also* FF 2-4). We find Figures 6 and 7 of Gudorf illustrate exemplary personalized web pages that are based on the aforementioned usage profile (i.e., user profile) where personalized graphics and textual composition elements are shown in the respective personalized

web pages, as inherently retrieved from a “composition store.” (FF 6). Therefore, we find the weight of the evidence supports the Examiner’s finding that the combination of Gudorf and Bradford teaches or suggests a user profile that comprises a reference to a composition store associated with a user, as claimed (See representative claims 37, 56, and 66).

ISSUE 2

We decide the question of whether Appellants have shown the Examiner erred in finding that the combination of Gudorf and Bradford teaches or suggests a browser having an applications program interface (API) and a user identification (ID) coupled to the API (See representative claim 37).

Appellants assert that Bradford appears to show an API, but not a browser, and Gudorf appears to show a browser, but not an API, and not OCR technology (App. Br. 14, last paragraph).

In response, we observe that the Examiner’s rejection is based on the *combination* of Gudorf and Bradford. Therefore, we are not persuaded by Appellants’ arguments because each of the arguments is directed to individual references in isolation rather than the combination of references as a whole. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Here, we find Gudorf expressly teaches the use of an HTML-compatible web browser (FF 1) in a network environment. Gudorf also expressly teaches a personalized on-line interface system 80 that

advantageously assesses the subjective preferences of a user who accesses a hypertext document or file from a remote on-line, network environment (FF 2). Gudorf further teaches a system 80 that “conveniently personalize[s] on-line content for the user 82 who uses multiple computer platforms 98 (e.g., home desktop computer, office computer, portable device).” (FF 3). The Examiner found that Gudorf inherently includes an API and that Bradford expressly discloses an API (Ans. 12-13, FF 11). We find Appellants have merely addressed the references separately and have not adequately traversed the Examiner’s findings regarding the *collective* teachings of Gudorf (FF 1-7) and Bradford (FF 8-11). Additionally, combining the teachings of both references, each of which teach connectivity in a network environment, would have been obvious to one of ordinary skill in the art. Therefore, we find Appellants’ arguments unavailing regarding ISSUE 2.

ISSUE 3

We decide the question of whether Appellants have shown the Examiner erred in finding that the combination of Gudorf and Bradford teaches or suggests using separate servers for the graphics store and composition store (See representative claim 37).

The Examiner states that the references were not relied on for providing separate servers as claimed (Ans. 13, ¶2). In the rejection the Examiner acknowledges that Gudorf does not specifically teach using separate servers for the graphics store and composition store (Ans. 4).

Nevertheless, the Examiner reasons that it would have been obvious for an artisan to have configured Gudorf's servers in the manner claimed because it would have allowed for greater processing performance and storage capacity (Ans. 5, ¶1).

We agree with the Examiner that dedicating servers to particular computing tasks would have been well within the knowledge and ability of an artisan at the time of the invention. We note that a person of ordinary skill is a person of creativity. "It is common sense that familiar items may have obvious uses beyond their primary purposes, and a person of ordinary skill often will be able to fit the teachings of multiple patents together like pieces of a puzzle." *KSR*, 550 U.S. at 402. Courts should "take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, 550 U.S. at 418. Here, we conclude that an artisan possessing common sense and creativity would have found it obvious to dedicate servers to particular types of computing tasks in the manner claimed. Moreover, even though differently labeled servers are claimed, they are not recited to be physically different from each other.

ISSUE 4

We decide the question of whether Appellants have shown the Examiner erred by improperly combining the Gudorf and Bradford references (See representative claims 37, 56, and 66).

We have considered Appellants' allegation of impermissible hindsight based on the premise that Gudorf and Bradford "address distinct problems using distinct solutions" (App. Br. 16). However, based upon our review of

the record, we find the Examiner's proffered combination of Gudorf and Bradford (and Gudorf, Bradford, and Gillespie) is merely a combination of familiar elements (i.e., a web browser, an application program interface (API), user profile information, various types of storage elements, servers, and optical character recognition (OCR)) that when combined according to known methods yield a predictable result. We are also in agreement with the Examiner's finding that the OCR system of Bradford is capable of performing OCR on data stored in a network (Ans. 13, ¶1; *see* FF 9).

Moreover, Appellants have provided no evidence to show that combining the respective familiar elements of the cited references in the manner proffered by the Examiner was "uniquely challenging or difficult for one of ordinary skill in the art" (*see Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418)). We find the Examiner has articulated a reasoning having a sufficient rational underpinning to support the legal conclusion of obviousness. Therefore, we find the record before us does not support Appellants' allegations of impermissible hindsight. Accordingly, we find Appellants have not shown the Examiner erred by improperly combining the cited references.

CONCLUSION

Based on the findings of facts and analysis above, Appellants have not established that the Examiner erred in rejecting claims 37-42, 44, 46-54, 56, 57, and 59-66 as being obvious over the cited prior art under 35 U.S.C. §103(a).

Appeal 2007-003926
Application 09/993,116

DECISION

The Examiner's decision rejecting claims 37-42, 44, 46-54, 56, 57, and 59-66 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

pgc

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